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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/820,212 | 04/06/2004 | Ulrich Kux | 104035.275702 | 3209 |

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| EXAMINER | |
|---|---|
| CAPPS, KEVIN J | |
| **ART UNIT** | **PAPER NUMBER** |
| 1617 | |

| NOTIFICATION DATE | DELIVERY MODE |
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| 04/16/2007 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/820,212 | Applicant(s) KUX ET AL. | |
|---|---|---|---|
| | Examiner Kevin Capps | Art Unit 1617 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 28 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

***Continuation Sheet from Advisory Action***

1. Applicant's arguments filed March 28, 2007 have been fully considered but they are not persuasive.

2. Regarding the rejection of claims 26-54 under 35 USC § 103 over Buisson (Applicant-cited reference on IDS: US 5,388,766) in view of Diec et al. (Applicant-cited reference on IDS: WO 96/28132, using US 6,607,733 as the English-language functional equivalent), Applicant argues that there would be no expectation of success in incorporating the microemulsion gel of Diec et al. into the dispenser of Buisson to arrive at the instantly claimed product. Applicant specifically argues that the ordinary skilled artisan would not expect that a high viscosity product such as a micoremulsion gel could be dispensed from the pump atomizer of Buisson. Applicant points to col. 11, lines 3-15 of Buisson, which states, "Fluids having viscosities higher than about 30 cps, such as in the 60-75 cps range, have been found to perform successfully with product delivery systems according to the present invention." Applicant argues, "The above passage of BUISSON makes it clear to one of ordinary skill in the art which type of fluids of 'comparatively higher viscosity' may successfully be dispensed (atomized) with the delivery system disclosed therein, i.e., products having viscosities of at least about 30 cps and up to 75 cps (or even somewhat higher than that)." (p. 4 of Remarks).

3. However, the Examiner disagrees with Applicant's interpretation of this passage. Buisson does not set an upper limit on the viscosities of the materials that can be successfully dispensed from the atomizer. Although 75 cps is the upper limit of the exemplified viscosity range, it is not the upper limit for the viscosities that can be

successfully employed. In other words, Buisson actually states that products with viscosities higher than 30 cps, such as 60-75 cps, can be successfully dispensed, not only products with viscosities of 30-75 cps, as Applicant suggests. For instance, Buisson exemplifies "lubricating oils", "surface coatings of all varieties", "salad dressings", and "flavored oils" as products that can be dispensed from the pump atomizer. The tables provided by Applicant on pp. 5-6 of the Remarks submitted on March 28, 2007 show that viscosities for such products are known to be far above 75 cps (see for example the Motor Oils and food products in the tables). Thus, Buisson clearly does not suggest that only products with viscosities lower than 75 cps could be successfully dispensed from the pump atomizer.

4. Applicant argues that the Examiner's assertion in the previous Office Action that "it is possible that Diec et al. did not appreciate that the more viscous formulations, such as the gels, could be dispensed from pump devices" suggests that the ordinary skilled artisan would not expect that microemulsion gels could be successfully dispensed from the pump atomizer of Buisson. However, as noted in the previous Office Action, this is precisely the problem that Buisson solves. Buisson provides a pump device that can be used to dispense higher viscosity products, such as microemulsion gels. Diec et al. may not have been aware of the pump device of Buisson, but upon reading Buisson, they, as well as other ordinary skilled artisans, would understand that their microemulsion gels could be dispensed from the pump device disclosed therein.

5. Applicant also poses the question why if Diec et al. explicitly state that aerosol containers, squeeze bottles and pump devices can be used to dispense aerosols, and

only "normal bottles and containers" for microemulsion gels, can it be inferred that pump devices could be used to dispense the microemulsion gels. First, it is noted that there is sufficient motivation to use the pump device of Buisson to dispense the microemulsion gel of Diec et al. in Buisson alone. Therefore, the ordinary skilled artisan would not need to look to Diec et al. for motivation to use the pump device of Buisson. However, it is possible that Diec et al. simply state that "normal bottles and containers" can be used to dispense the microemulsion gels because they envision that a wider range of dispensers can be used to dispense the gels as opposed to aerosols. In any event, in no way do they teach away from using a pump device to dispense the gels, particularly in view of Buisson, which teaches that his pump device can be used to dispense viscous products.

6. Applicant requests withdrawal of the double-patenting rejections for the reasons presented against the § 103 rejection. Therefore, the double-patenting rejections are properly maintained for the reasons stated above.